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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,218	05/07/2002	Marcus Filshie	02597	2627

987 7590 12/01/2004

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,218

Applicant(s)

FILSHIE ET AL.

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04-08-04, 05-07-02</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 01-15-02</u> . |

DETAILED ACTION***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,846,255 to Casey in view of U.S. Patent No. 4,822,348 to Casey. Casey '255 discloses all of the structural features of the claimed invention, excepting that his liner is not made out of silicon rubber. Casey '255 discloses a surgical clip with upper jaw (12) and lower jaw (10), attached together at hinge (16/18) [Fig.]. The lower jaw has latching means (30), which engages with generally straight section (28) when the clip is closed [Column 3, lines 56-65; see Fig. 2B]. Lower jaw (10) has a "resilient cushioning material" (42) as a liner, but it is not specifically disclosed as being silicon rubber. The upper jaw (12) has a complex shape including a straight section (general area of part 22), and an arcuate shaped section (36) [see Attachment #1]. In Attachment #1, the straight section is striped, the first portion (larger radius of curvature) has circles, and the second portion has stars. The radius of curvature of the first portion is very clearly greater than the second portion; that is, the first portion curves more slightly than the second portion.

Casey '255 makes reference [see Column 1, lines 19-20] to his previous patent (U.S. 4,822,348), in which the liner is made specifically out of silicone rubber. In the

older patent, Casey teaches that there are different materials that are safe for implantation within the human body, one of them being silicone rubber. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to choose to make the lining out of silicone rubber (as opposed to other foams and rubbers), as a mere matter of design choice, as taught by Casey '348.

2. Regarding Claim 2, Casey '255 discloses generally straight section (28) [Fig. 1].
3. Regarding Claim 3, Casey's first radius of curvature is of the order of three times that of the second radius of curvature. Without measuring, (estimating) Examiner estimates that the first radius of curvature is about 7 times that of the second radius of curvature. Applicant is invited to measure them using a protractor. Seven is considered to be of the same order as three.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,478,218 to Mericle

Publication No. 2003/0074009 to Ramsey et al.

Publication No. 2004/0116948 to Sixto et al.

U.S. Patent No. 4,122,944 to Williams

U.S. Patent No. 4,346,869 to MacNeill

U.S. Patent No. 4,589,626 to Kurtz et al.

U.S. Patent No. 4,620,541 to Gertzman et al.

Art Unit: 3731

U.S. Patent No. 4,807,622 to Ohkaka et al.

U.S. Patent No. 4,638,804 to Jewusiak

U.S. Patent No. 4,733,666 to Mercer

U.S. Patent No. 5,549,619 to Peters et al.

U.S. Patent No. 5,522,823 to Kuntz et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP
BCP

November 18, 2004

[Signature]
ANH TUAN T. NGUYEN
PRIMARY EXAMINER
4/23/04

